

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Group I, claims 1 and 3-12, in the reply filed on 2/26/08 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The reply is not fully responsive to the Requirement mailed 11/27/07 for the reasons given below.

Additionally, Applicant is advised that upon further consideration, the Requirement as applied to Groups I, II, III, IV, and VI is withdrawn. As a result, Groups I-IV and VI are rejoined for examination on the merits. The requirement as applied to the invention of Group V is maintained.

Furthermore, the alternatives recited in claims 3, 4, 7, 8, 11, 12, 14, 15, and 18 (see page 4 of the Requirement) are considered to be different species of the claimed invention rather than inventions per se. The reasons why each species is considered to lack unity of invention remain the same as those set forth in the original Requirement at pages 4-5. Claims 1, 13, and 17 are generic to said species. See below.

Altogether, then, claims 1, 3-18, 20, and 21 are considered to read on the elected invention.

Claim 19 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2/26/08.

Claims 1, 3-18, 20, and 21 are under consideration but require further elections, as explained below.

***Notice of Non-Fully Responsive Reply***

The reply filed 2/26/08 is not fully responsive to the Requirement mailed 11/27/07. In particular, Applicant has not elected a single species of the claimed invention from claims 3, 4, 7, 8, 11, 12, 14, 15, and 18, as required.

As explained at page 4 of the Requirement, claims 3, 4, 7, 8, 11, 12, 14, 15, and 18 are drawn to a plurality of different methods that do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. The different methods are considered to represent different species of the generic invention. The species of claims 3, 4, 7, 8, 11, 12, 14, 15, and 18 are deemed to lack unity of invention *a priori* because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

1. **Claims 3 and 4:** Whereas the method recited in claim 3 requires the step of determining an increase in the amplitude of the signal, the method of claim 4 requires determining a decrease in amplitude. The different methods may each require an aptamer, but the aptamers would likely have different designs and/or binding affinities relative to the substrate and product. Therefore, the species of claims 3 and 4 do not share the same special technical feature. Applicant must

elect the method of claim 3 or 4 for prosecution on the merits with the elected invention.

2. **Claims 7 and 8** require signaling aptamers for detecting either the addition or removal of a functional group to a substance A. Applicant must elect the method of claim 7 or 8. The election must be consistent with the election in claims 3 and 4 as well as all other claims herein.
3. **Claims 9, 11, 12, and 18** recite at least 6 alternative substrates and 4 to 5 alternative classes of enzymes that would necessarily require separate and distinct aptamers, reactions, and assays, each having a different special technical feature relative to the other. Furthermore, claim 9 would appear to claim yet another variant, involving a phosphorylation reaction. The different enzymatic reactions would most likely require separate, structurally distinct aptamers, substrates, and method steps for monitoring the reactions catalyzed by each enzyme. Applicant must elect one substrate, one enzyme corresponding to said substrate, and thereby one reaction for prosecution on the merits.
4. Similar reasoning applies to **claims 14 and 15**. Applicant must elect either a method involving an increase in signal intensity or decrease in signal intensity. To be responsive, the election in claims 14 and 15 must be consistent with the election made in claims 3, 4, 7, and 8.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify

the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 1, 13, and 17.

### ***Conclusion***

A telephone call was made to Y. Rocky Tsao on 28 April 2008 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

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The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis Wollenberger whose telephone number is (571)272-8144. The examiner can normally be reached on M-F, 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James (Doug) Schultz can be reached on (571)272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Louis Wollenberger/

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